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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,496	12/28/2001	Yeh-Hung Lai	81880PAL	8406

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,496

Applicant(s)

LAI ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 5/27/2005. Claim 9 has been cancelled, and new claim 21 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' arguments over Bourdelais and Shirai are persuasive, as such the rejections in sections 9 and 10 in Office action dated 2/25/2005 are withdrawn.

Rejections Based on Prior Art

4. Claims 2-8 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dontula et al. (US 6447976), generally as set forth in section 6 of Office action dated 2/25/2005, together with the following response to argument.

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Claims 1, 3, 5, 6, 8, 9, 10-12 and 24 of Dontula '976 disclose all the features of instantly claimed invention (an imaging member having a base formed of thermoplastic closed cell foam core sheet, and adhered thereto an upper and lower polymer sheets, etc.), except the modulus and toughness properties of each layer. However, Dontula '976 does teach that the modulus of the foam core ranges between 30 MPa and 1000 MPa, and the modulus of the flange sheets ranges from 700 MPa to

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10500 MPa (column 6, lines 23-29), which reads on the modulus of each layers of instant invention as claimed. Further, Dontula also expressly teach that the upper and lower sheets are chosen to satisfy specific requirements of flexural modulus. In particular, at stiffness (modulus) above a certain maximum, there is a problem with the element in cutting, punching, slitting, and chopping during transport through a photofinishing equipment (column 5, lines 45-64). As such, in the absence of evidence to the contrary, since Dontula '976 teaches the same subject matter (a foam core imaging element of the same polymer), and for the same application (having suitable cutting, slitting and chopping properties to be processed through a photofinishing equipment) as the instant invention, it is the Examiner's position that a suitable toughness of each layer is also clearly anticipated by Dontula '976.

Applicants' argument "The Examiner has no basis for the statement that the toughness of each layer is fairly anticipated by Dontula (976). Dontula does not set forth toughness. Toughness is dependent upon issues such as chemical structure, cross-linking, and the amount and direction of orientation of the polymer sheet. It is not directly dependent upon modulus and toughness may differ substantially among similar modulus materials. In view of the failure to disclose toughness, the Examiner cannot properly consider the Dontula (976) reference as anticipating the property of toughness. Toughness is more important in relation to cutting of the sheet than modulus and this property is a property of interest in the instant application" (Remarks, page 4, second paragraph) has been carefully considered, but is not persuasive. First, the Examiner repeats that Dontula '976 teaches the same subject matter (a foam core imaging

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element of the same polymer), and for the same application (having suitable cutting, slitting and chopping properties to be processed through a photofinishing equipment) as the instant invention, as set forth above, and nowhere does Dontula '976 teach an imaging element which differs from the instant invention in chemical structure, cross-linking, and the amount and direction of orientation of the polymer sheet, as such, in the absence of evidence to the contrary, the Examiner repeats that a suitable toughness of each layer is also clearly anticipated by Dontula '976. It should be noted that it is well settled that in the absence of factual support, Attorney arguments cannot take the place of evidence. Second, the Examiner would like to remind Applicants of their own teaching in the specification that "modulus and tensile toughness can be determined using a tensile test such as that described in ASTM D638. A tensile test consists of slowly pulling a sample of material with a tensile load until it breaks ... From the load and elongation history, a stress-strain curve is obtained with the strain being plotted on the x-axis and stress on the y-axis. The modulus is defined as the slope of the initial linear portion of the stress-strain curve. The modulus is a measure of a material's stiffness. The tensile toughness is defined as the area under the entire stress-strain curve up to the fracture point. The tensile toughness is a measure of the ability of a material to absorb energy. Both modulus and tensile toughness are fundamental mechanical properties of material." (specification, page 9, lines 6-16). In other words, clearly modulus and toughness are measured by the same testing method and the same set of testing data, only expressed in different terms. As such, the Examiner repeats that since Dontula '976 discloses the same subject matter made of the same

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material as the instant invention, and reads on the modulus of instant invention, the Examiner re-asserts that, in the absence of evidence to the contrary, a suitable toughness is also anticipated by Dontula '976, Applicants' argument to the contrary notwithstanding.

For newly added claim 21, the Examiner notes that claim 12 of Dontula '976 expressly claims that the imaging layer comprises an ink jet receiving layer.

5. Claims 2-8 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dontula et al. (US 6537656), generally as set forth in section 7 of Office action dated 2/25/2005, together with the same reasoning as set forth above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

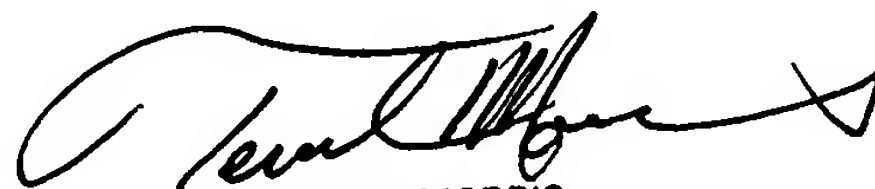
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC
Victor S Chang
Examiner
Art Unit 1771

6/28/2005


TERREL MORRIS
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